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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/049,656      | 02/13/2002  | Hubert Baumgart      | IN-5554             | 7707             |

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EXAMINER

SERGEANT, RABON A

ART UNIT PAPER NUMBER

1711

DATE MAILED: 06/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/049,656

Applicant(s)

BAUMGART ET AL.

Examiner

Rabon Sergeant

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 May 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 21,23,25-37,42 and 43 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 21,23,25-37,42 and 43 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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1. A request for continued examination under 37 CFR 1.114 was filed in this application after appeal to the Board of Patent Appeals and Interferences, but prior to a decision on the appeal. Since this application is eligible for continued examination under 37 CFR 1.114 and the fee set forth in 37 CFR 1.17(e) has been timely paid, the appeal has been withdrawn pursuant to 37 CFR 1.114 and prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on May 8, 2006 has been entered.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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3. Claims 21, 27-31, and 33-37 are rejected under 35 U.S.C. 102(a) as being anticipated by WO 00/15725.

The reference discloses polymeric coating compositions wherein diethyloctanediol is disclosed as a reactant. See page 15, line 10. Though the reference fails to disclose the particular isomer used, the claims are considered to be met despite applicants' argument, because the claims encompass all position isomers. The examiner has considered applicants' arguments; however, the rejection has been maintained for the following reasons. Firstly, the position is taken that the reference discloses the use of diethyloctanediol as a monomer in the production of a polymeric varnish; therefore, one would have recognized that polymeric compositions containing the argued repeating units are present, since the polymerization of the argued monomers will yield the argued repeating units. Secondly, without further definition, no definitive meaning can be ascribed to the "curable" language of the claims that justifies removal of the prior art rejection.

4. Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

5. Claims 21 and 27-31 are rejected under 35 U.S.C. 102(b) as being anticipated by GB 778924.

The reference discloses polymeric compounds produced from 3,6-diethyl-1,8-octanediol. See page 4, lines 55 and 75-85. Despite applicants' remarks, the position is taken that the skilled artisan would immediately envisage the use of the saturated diethyloctanediol within the disclosed polymers at page 4, lines 75-85. Despite applicants' argument, the position is

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maintained, in view of a polymer's definition requiring repeating units and the fact that polymers, such as polyesters, are derived from repeating polyol monomer units, that the disclosed polymers (i.e.; the polyesters at page 4, line 76) inherently satisfy the argued "two or more monomer units" language. Despite applicants' arguments, the language, "these glycol products", at page 4, line 75 is considered to encompass the disclosed 3,6-diethyl-1,8-octanediol species. The examiner finds no convincing rationale why this species should be excluded from the aforementioned "glycol products". Additionally, to the extent that the meaning of "curable" is understood, the position is taken that the disclosed "drying oil" types of polyesters satisfy applicants' requirement that the composition be "curable" and contain the argued units. To the extent claimed, it is not seen that "curable" conveys any specific limitation to the claims other than requiring that the composition be able to be cured in some fashion.

6. Claims 21, 23, 25-37, 42, and 43 are rejected under 35 U.S.C. 102(a) as being anticipated by EP 940459.

The reference discloses coating and adhesive compositions derived from various diethyloctanediols, including 2,4-diethyloctane-1,5-diol. See page 2 and claims. As aforementioned, without further definition, no definitive meaning can be ascribed to the "curable" language of the claims that justifies removal of the prior art rejection.

7. Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

8. Within polymeric systems, it is uncommon for weight average molecular weights and number average molecular weights to be equivalent; therefore, it is common for the

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polydispersity of such systems to exceed unity, often by a considerable margin; therefore, with respect to the rejections set forth within paragraphs 3-7, though the relied upon references fail to specifically recite applicants' claimed polydispersity range, the position is taken in view of the breadth of the claimed range and the preceding rationale that the claimed polydispersity range is inherently met by references. Applicants have not established that the prior art compositions possess polydispersity values outside of the claimed range.

9. Claims 21, 23, 25-37, 42, and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 00/15725 or GB 778924 or EP 940459.

As aforementioned, the references disclose the use of diethyloctanediol in the production of polymers, suitable for use as coatings and adhesives.

10. Though the references fail to disclose each of applicants' claimed isomers, the position is taken that it would have been obvious to utilize any isomer of diethyloctanediol in the production of polymers, based upon the teachings of the references. The basis for this position resides with the expectation that compounds that have a close structural similarity possess similar properties. *In re Wilder*, 563 F.2d 457, 195 USPQ 426 (CCPA 1977). *In re May*, 574 F.2d 1082, 197 USPQ 601 (CCPA 1978). This position is bolstered by the fact that the utility and function of the argued compounds within polymerization reactions were well understood; therefore, the skilled artisan would have had a reasonable expectation of success in substituting one compound for another.

11. Applicants' response has been considered; however, it is not seen that the response adequately rebuts the position that compounds having close structural similarities are expected to possess similar properties and, as a result, are obvious in view of each other. Furthermore,

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applicants have based their response on the limitation that the compositions containing the argued units are “curable”; however, to the extent that “curable” is defined, the position is taken that no meaningful limitation can properly be ascribed to the language. The examiner’s position with respect to polydispersity has been set forth within paragraph 8.

Any inquiry concerning this communication should be directed to R. Sergent at telephone number (571) 272-1079.

  
**RABON SERGENT**  
**PRIMARY EXAMINER**

R. Sergent  
June 20, 2006